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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,522	09/07/2000	George Gerpheide	0672.CIRQ.NP	9011

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EXAMINER

NGUYEN, JENNIFER T

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,522

Applicant(s)

GERPHEIDE ET AL.

Examiner

Jennifer T Nguyen

Art Unit

2674

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: _____

Art Unit: 2674

DETAILED ACTION

Drawings

1. The drawings are objected to because the blank boxes (52, 54, 56, 58, 60, 62) in figure 6 should be labeled . A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2674

3. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Donohue et al. (U.S. Patent no. 6,262,717).

Regarding claim 1, referring figures 3-6, Donohue teaches a touchpad keyboard for entering data into a portable electronic appliance, said touchpad keyboard comprising: a capacitance sensitive touchpad (21) including circuitry for detecting and localizing an object on a surface thereof; an overlay (31) disposed on the surface (26) of the touchpad keyboard, wherein the overlay provides visual feedback that corresponds to signals that will be generated therefrom when certain areas of the touchpad keyboard are pressed col. 8, lines 31); and a communications port (57) for transmitting signals corresponding to keys on the touchpad keyboard (21) (col. 10, lines 12-13).

Regarding claim 2, referring to figure 4, Donohue teaches the touchpad keyboard (21) further comprises an audio feedback system which causes a recorded voice to state a name of a key that is touched on the touchpad keyboard (col. 9, lines 60-63 and from col. 9, line 65 to col. 10, line 1-6).

Regarding claim 4, referring to figure 4, Donohue teaches the touchpad keyboard (21) further comprises a communications cable (57) that is coupled to the communications port to thereby enable remote coupling to a portable information appliance (col. 10, lines 12-16).

Regarding claim 5, referring to figures 3 and 6, Donohue teaches the touchpad keyboard (21) comprises tactile feedback to a user, wherein each separate key on the overlay is separated

Art Unit: 2674

from all other zones by a raised ridge of material to thereby more discretely separate zones thereon (col. 9, lines 11-20 and col. 11, lines 1-10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. (U.S. Patent no. 6,262,717) in view of Will (U.S. Patent no. 5,825,353).

Regarding claim 3, Donohue teaches all the subject matters as claimed except for a scrolling wheel disposed in a side such that a user can rotate the wheel to thereby cause data on a display screen to scroll up or down. However, Will teaches a scrolling wheel (3) (figure 1) disposed in a side such that a user can rotate the wheel to thereby cause data on a display screen to scroll up or down (col. 4, lines 61-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the scrolling wheel as taught by Will in the system of Donohue in order to allow simple and effective control of applications and also allow the entry of alphanumeric data without the necessity of a keyboard.

Art Unit: 2674

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. (U.S. Patent no. 6,262,717).

Regarding claims 6 and 7, referring to figures 3-6, Donohue teaches a data input device for navigating web pages which are displayed on a web browser terminal, and for entering alphanumerical data therein (col. 11, lines 38-44), said data input device comprising: a touch-sensitive surface which is disposed within the housing and which functions as a keyboard having discrete locations which define keys thereon (col. 10, lines 32-42); a touch-sensitive surface which is disposed within the hand-held housing and which functions as a touchpad device for cursor control and navigation of the web pages (from col. 10, line 64 to col. 11, line 1); a means for providing audible feedback to a user, to thereby provide precise information as to which key on the keyboard was touched by the user (from col. 9, line 60 to col. 10, line 9); and a communications link between the keyboard, the touchpad and the web browser terminal which at least transmits and receives data therebetween (col. 10, lines 12-16 and col. 11, lines 38-44).

Donohue differs from claims 6 and 7 in that he does not specifically teach the data input device is a hand-held data input device. However, it would have been obvious to obtain a hand-held data input device in order to provide a lightweight compact form to facilitate carrying.

6. The prior art made of record and not relied upon the is considered pertinent to applicant's disclosure.

Gerpheide et al. (U.S Patent No. 5,767,457) teaches apparatus and method for audible feedback from input device.

Art Unit: 2674

Stephan et al. (U.S. Patent No. 5,748,185) teaches touch with scroll and pan regions.

Gerpheide et al. (U.S. Patent No. 6,222,528) teaches method and apparatus for data input.

Gerpheide (U.S. Patent No. 5,305,017) teaches methods and apparatus for data input.

Conclusion

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Jennifer T. Nguyen whose telephone number is 703-305-3225. The examiner can normally be reached on Mon-Fri 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached at 703-305-4709.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks

Washington, DC. 20231

Or faxed to: 703-872-9314 (for Technology Center 2600 only)

hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, sixth-floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-3-6-0377.

Application/Control Number: 09/656522

Page 7

Art Unit: 2674

Jennifer T. Nguyen

Patent Examiner

Art Unit 2674

A handwritten signature in black ink, appearing to read 'R. Hjerpe', written in a cursive style.

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600